



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/525,491	03/15/2000	Mary Thomasma Tackbary	9203/031c3	9815

24283 7590 11/20/2002

PATTON BOGGS  
PO BOX 270930  
LOUISVILLE, CO 80027

EXAMINER

POND, ROBERT M

ART UNIT PAPER NUMBER

3625

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/525,491

Applicant(s)

TACKBARY ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 45-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Response to Amendment***

The Applicant cancelled Claims 1-25, 28, 29, and 31-43. Claims 26, 27, 30, and 44 were cancelled and Claims 45-80 were added in Preliminary Amendment B. All pending Claims (45-80) were examined in this non-final amendment.

***Response to Arguments***

Applicant's arguments with respect to Claims 45-80 have been considered but are moot in view of the new ground(s) of rejection. New art was cited to address claims pertaining to use of a mail list and the use of mail list from external sources. The applicant argues that the system and method of Cannon et al. is based on a single transaction which do not provide the customer with the capability to store data relating to: multiple recipients, recipient addresses, recipient occasions, order history, or order status. Cannon et al. remains as the base reference and maintains an order history at least up to the point of order completion dictated by a shipping date (please see Fig. 19 (70, 71); Fig. 20b (79) and in effect supports on-going management at least to this point, allows a customer to send cards to multiple recipients, store recipient addresses and recipient occasion information. Furthermore, Cannon et al. a) note a known problem of card purchasers not remembering what card designs they have previously sent someone and being concerned about sending duplicates of cards previously sent, and b) flag order status to note order progress. This examiner noted below in the DETAILED ACTION that Cannon et al. substantially describe

Art Unit: 3625

instant claims 45, 57, and 69, and provide motivation to help the customer remember what cards were previously sent to a recipient. Instant Claims 45-80 do not claim order history in any claim element.

### **DETAILED ACTION**

#### ***Double Patenting***

The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time-wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 45, 57, and 69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 51, 68, and 72 of U.S. Patent No. 5,960,412, and claims 1, 21, 31, 41, 45, and 49 of U.S. Patent No. 6,092,054. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant

application claim subject matter pertaining to system, method, means, and program code of electronically viewing, ordering, and delivering a social expression card to a recipient.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2. Claim 45, 50-53, 57, 62-65, 69, and 74-77 are rejected under 35 USC 103(a) as being unpatentable over Cannon et al., patent number 5,552,994, in view of Official Notice regarding customer order modifications.**

Cannon et al. teach a system, method, means, databases, and programs for viewing, ordering, and printing social expression cards for customers who remotely order greeting cards over a computer network. Cannon et al. teach printing cards at the user location or at remote locations, a database defining the layout of selected cards by occasion (e.g. Birthday), displaying graphical images, personalizing messages, transacting multiple card orders, recipient information, envelop printing, and delivery modes. Cannon et al. teach a known problem of card purchasers not remembering what card designs they have previously sent to a recipient and concerns about sending duplicates of cards previously sent, an

Art Unit: 3625

order information database, multiple modes of delivery (e.g. mail or delivered as noted in prior art), order information storage and retrieval, and unique order identifiers to retrieve orders (see at least abstract; Fig. 1 (15, 19); Fig. 3 (40, 50); 3a (36); Fig. 18 (52, 54, 66, 67, 68); col. 1, line 15 through col. 5, line 39).

Cannon et al. teach storing order information in at least one database, the data in the order information database including a plurality of recipient data records for a customer, and each recipient data records containing data that defines a recipient, and logically linking order information with card image, personalized messages, receiver and sender data, and order status data (see at least Fig. 19 (70, 71); col. 17, lines 3-8; lines 22-25; col. 18, lines 29-31). Cannon et al. teach linking the recipient data with social expression card data containing data which defines at least one social expression card, and forming linked data (see at least Fig. 19 (71, 72, 73); col. 18, lines 29-31). Cannon et al. further teach the following:

- Providing a customer interface to access databases and image files stored in a central data storage unit which may be accessed at a card display/order site facility and a card printing facility (see at least Fig. 18 (65, 66); col. 4, lines 56-59),
- Assigning each customer order with a unique order code and the order code being stored in the order information database and retrieved by the card printing facility for processing (see at least Fig. 19 (74); col. 4, lines 6-8; col. 18, line 59),

Art Unit: 3625

- Receiving an order initiated by a customer transmitting the order to a card printing site (see at least col. 17, lines 22-25;),
- Printing and shipping cards ordered by a customer, with order information stored in an order information database (see at least Fig. 20b (79)),
- Updating the order information to reflect the date the orders was processed and shipped (see at least Fig. 19 (85, 86); col. 19, lines 63-65), and
- Noting a known problem of card purchasers not remembering what card designs they have previously sent someone and being concerned about sending duplicates of cards previously sent (see col. 3, lines 50-55).

Cannon et al. teach all the above as noted under the 103(a) rejection but do not disclose the customer accessing the databases to make a change to an order. This examiner takes the position that Cannon et al. substantially describe a system and method that allow the customer to initiate the delivery of social expression cards by an order fulfillment center, either as a first time order or a modified order. This examiner takes the position should a customer decide to change the delivery date or any other type of supplied information (e.g. typing error, occasion date change beyond customer control necessitating a delivery date change, changing personalized message), it would be a reasonable expectation on the part of the customer to be able to initiate changes due to

human error or events beyond the control of the customer, if not via the customer terminal then simply by sending in a hand written order form via facsimile transmission to make the necessary changes (see at least col. 17, lines 3-13). Furthermore, since the order status is updated in the customer order information, the customer would be able to determine order status through the order site, or at least via facsimile transmission requesting an order status update. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Cannon et al. to allow customer access to order data once entered to review or modify the order as taught by Official Notice, in order to provide customer service flexibility and better convenience to the customer, and thereby attract more customers to the site.

- 3. Claims 46, 47, 58, 59, 70, and 71 are rejected under 35 USC 103(a) as being unpatentable over Cannon et al., patent number 5,552,994, and Official Notice regarding customer order modifications, as applied to Claims 45, 57, and 69, and further in view of Official Notice regarding express couriers.**

Cannon et al. and Official Notice teach all the above as noted under the 103(a) rejection and further teach using mail or other purchaser delivery, but do not specifically disclose indicating to the customer multiple modes of delivery. This examiner takes the position that consumers and businesses use express couriers as alternative modes of mail or package delivery under circumstances



where urgent delivery is required to meet a certain delivery date or to expedite delivery once past a certain delivery date. Therefore it would have been obvious to one of ordinary skill in the art at time of invention to modify the system, method, and means of Cannon et al. and Official Notice to provide the customer with multiple modes of delivery in order to better service the customer as taught by Official Notice, in order to better meet customer delivery requirements, and thereby attract repeat customers.

- 4. Claims 48, 49, 60, 61, 72, and 73 are rejected under 35 USC 103(a) as being unpatentable over Cannon et al., patent number 5,552,994, and Official Notice regarding customer order modifications, as applied to Claims 45, 57, and 69, and further in view of Hayes (PTO-892 Item: U).**

Cannon et al. and Official Notice teach all the above as noted under the 103(a) rejection and further electronic shopping, ordering, and delivering social expression cards remotely or from a greeting card shop, but do not disclose selecting a gift to be included with the card. Hayes teaches Bullock & Jones combining a gift with a card selected through a mail-order catalog shopping service that offers various forms of electronic shopping to better service customers. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Cannon et al. and Official Notice to provide a card and gift combination as taught by Hayes, in order to provide electronic shoppers a social occasion service capable of providing

Art Unit: 3625

customers with a complete gift purchasing and card giving service emulating catalog services or in-store experiences, and thereby attract more customers to the site.

- 5. Claims 54-56, 66-68, and 78-80 are rejected under 35 USC 103(a) as being unpatentable over Cannon et al., patent number 5,552,994, and Official Notice regarding customer order modifications, as applied to Claims 45, 57, and 69, further in view of Chartock (PTO-892 Item: V), and further in view of Mail List Management (a collection of articles cited in PTO-892 Items: W and X).**

Cannon et al. and Official Notice teach all the above as noted under the 103(a) rejection and teach a) desktop publishing systems (e.g. Pagemaker, QuarkXpress) allowing users to create custom publications, newsletters, brochures, b) using desktop publishing systems to create custom greeting cards, invitations, and business cards (see at least col. 2, lines 39-47), and c) using a mail management program (col. 18, line 25), but do not disclose the use of a mailing list of recipients or importing a mailing list. Chartock teaches desktop publishing and word processing being unified, and further teaches mail list management being integrated into desktop publishing-word processing products (see Item: V, page 1). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Cannon et al. and Official Notice, to include mail list management with desktop

publishing applications as taught by Chartock, in order to provide more convenience to the customer in managing recipient lists, and thereby attract more customers to the site.

Cannon et al., Official Notice, and Chartock teach all the above as noted under the 103(a) rejection and further teach integrating mail list management with desktop publishing and word processing but do not disclose specifics on mail list management functionality. Mail List Management teaches List&Mail, a mail list manager that allows users to create separate sub-lists with addresses drawn from the main file list (see Item: W, pages 8-9), and importing mail lists from external sources (e.g. Label Master, List Pro II, Mail-Track-II) (see at least Item: W, pages 7, 10, and 12). Mail List Management teaches desktop publishing systems to create newsletters and mailing lists comprising employees, potential customers, sales representatives, distributors, editors of appropriate business or trade publications, and influential friends and colleagues (see Item: X, pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Cannon et al., Official Notice, and Chartock to create and manage mailing lists and imported mailing lists of recipients as taught by Mail List Management, in order to help customers better manage their recipient lists, and thereby attract more customers to the site.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

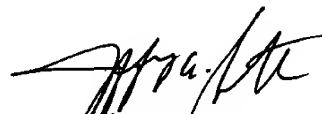
***Washington D.C. 20231***

or faxed to:

**703-305-7687** (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

RMP  
November 18, 2002

  
JEFFREY A. SMITH  
PRIMARY EXAMINER